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EXAMINER

MERCIER, MELISSA S

ART UNIT

PAPER NUMBER

1615

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DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/718,213	Applicant(s) JACOBSON-ALTIT, JILLIAN	
	Examiner MELISSA S. MERCIER	Art Unit 1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 11-17 is/are pending in the application.
- 4a) Of the above claim(s) 3 and 4 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-2, 5-6, 11-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Summary

A patentability conference was held on August 27, 2008 between Michael Woodward, SPE, Fredrick Krass, SPE and Melissa Mercier, Examiner. Based on the amendments presented and the 132 Declaration, it was determined the claims are not in condition for allowance.

The finality of the previous office action dated May 5, 2008 has been withdrawn. The following rejections are either maintained or newly applied and constitute the entire set of rejections in the instant application. Applicants Remarks, 132 Declaration, and Amended Claims filed on August 4, 2008 after the final rejection have been entered.

Claims 1-6, 11-17 remain pending. Claims 3-4 remain withdrawn. Claims 1-2, 5-6, and 11-17 are under prosecution in this office action.

Maintained Rejections

Claim Rejections - 35 USC § 103

Claims 1-2, 5-6, and 11-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shanni (US Patent 5,631,012) in view of Deckers et al. (US Patent 6,372,234).

Shanni discloses lip pomade comprising 5.00% ozokerite, 10.00% isopropyl myristate, and a fragrance/flavor portion (Example 6). Pomade is defined as a perfumed oil or ointment by dictionary.com and would therefore be considered a liquid formulation.

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Shanni does not disclose the use of a colorant, preservative, in the formulation.

Deckers teach a cosmetic composition comprising oil bodies suitable for use in lipsticks, lip-glosses, lip balms and lip pencils.

Deckers cosmetic composition further comprises fragrances. Deckers defines a fragrance as any component reacting with the human olfactory sites and imparting a pleasurable odor, essence, or scent. Fragrances taught by Deckers include linear and cyclic alkenes, primary, secondary, and tertiary alcohols, ethers, esters, ketones, nitrites, and saturated and unsaturated aldehydes" (column 17, lines 18-52).

The use of a preservative in order to treat against contamination by bacteria, fungi and viruses is disclosed (column 13, lines 21-26).

Deckers further discloses the additon of pigments, including titanium dioxide, zinc oxide, black, yellow, red and brown iron oxides, for example (column 22, lines 47-56); antioxidants, including plant extracts (column 23, lines 1-12).

Deckers teaches the use of esters including C_8 - C_{30} alkyl esters of C_8 - C_{30} carboxylic acids; C_1 - C_6 diol monoesters and diesters of C_8 - C_{30} carboxylic acids; C_{10} - C_{20} alcohol monosorbitan esters, C_{10} - C_{20} alcohol sucrose di- and tri- esters; C_{10} - C_{20} alcohol sucrose mono-, di-, and tri- esters; and C_{10} - C_{20} fatty alcohol esters of C_2 - C_6 2 hydroxyacids, examples included sorbitan esters (column 16, lines 41-53). It is the examiners position that since sorbitan esters are disclosed and it is known in the art that they are useful in cosmetic formulations, it would have been obvious to substitute on for another with the expectation that they would function similarly.

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The instant claims differ from the references only in the specific percentage selected for the compositions. However, It would have been deemed prima Facie obvious to one having ordinary skill in the art at the time of the invention to optimize the percentage of bodying agents, odorants, and flavorants to prepare a composition containing for topical treatment to the lips because the determination of a specific percentage having the optimum therapeutic effect is well within the level of one having ordinary skill in the art, and the artisan would be motivated to determine optimum amounts to get the maximum effect of the active compounds. Therefore, the invention as Whole has been prima face obvious to one of ordinary skill in the art at the time the invention was made.

It is generally considered to be prime facie obvious to combine compounds each of which is taught by the prior art to be useful for the same purpose in order to form a composition that is to be used for an identical purpose. The motivation for combining them flows from their having been used individually in the prior art, and from them being recognized in the prior art as useful for the same purpose. As shown by the recited teachings, instant claims are no more than the combination of conventional components of commonly known to be used in the art of lip stick/gloss compositions. It therefore follows that the instant claims define prime facie obvious subject matter. Cf. In re Kerhoven, 626 F.2d 848, 205 USPQ 1069 (CCPA 1980).

Response to Arguments

Applicant's arguments have been fully considered but they are not persuasive. While the Examiner acknowledged and concedes the Shanni reference **requires** vernix either natural or synthetic, as an essential material to improve skin softness, flexibility, plasticity and moisturization, it is taught for being used for its moisturizing/emollient properties. The instant claims recite the use of an alkyl ester, which is another art recognized emollient. Therefore, the instant claims recognize the need for an emollient and have merely selected a different component in order to meet that need of the lip care formulation. Applicant has also amended the claims to recite the composition is stable. There is nothing in the prior art reference to indicate the composition is not stable. Applicants use of the terminology "consisting essentially of" does not exclude the presence of the vernix as recited in the prior art since the instant specification has defined the term to be:

The term "consisting essentially of" is used in its art-recognized meaning to indicate that the composition is open to the inclusion of unstated other ingredients only to the extent that such other ingredients do not materially affect the desirable and beneficial properties of the defined composition. Major amounts of water, for example, are excluded as likely to cause phase separation and other manifestations of instability in the composition of the invention, while small amounts of water as may be present as a result of exposure to humidity can be tolerated.

The material effect is the desirable and beneficial properties of the defined composition. Therefore, since the Shanni reference discloses the vernix to be useful for the same desirable and beneficial properties as the emollients used in the instant claims, it is not altering the material effect of the composition.

Response to Amendment

The Declaration under 37 CFR 1.132 filed August 4, 2008 is insufficient to overcome the rejection of claims 1-2, 5-6, and 11-17 based upon obviousness over Shanni in view of Decker as set forth in the last Office action because: as discussed above, there is nothing in the prior art to disclose the composition of Shanni is unstable and the material effect of the composition using vernix is not material altering the beneficial and desirable properties, as defined by Applicants definition.

Newly Applied Rejections

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-2, 5-6, and 11-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rose, III et al. (US Patent 6,723,307).

Rose discloses sour tasting cosmetic lip products containing 2-25% by weight acid (abstract). One or more acids can be used (column 3, lines 13-16). The acid is disclosed as a flavorant. The acid is dissolved in a cosmetic base such as oils, emollients, and moisturizers (column 2, lines 33-369). Additional flavor enhancers can be added in the amount of 0.5% to about 2.0% by weight (column 5, lines 34-36). The lip care product may also contain preservatives, antioxidants, colorants, and fragrances (column 4, lines 14-18). The formulation will have the consistency of a lotion or cream (column 2, lines 53-54), which reads on liquid as recited in the instant claims. The oils

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of the cosmetic base include emollients such as fatty esters, fatty alcohols and silicone oils, including isopropyl palmitate, polybutene and petrolatum (column 4, lines 20-28). Waxes including ozokerite are also disclosed (column 4, lines 29-37). The preferred amount of the cosmetic base is 55-90% by weight of the final product (column 4, lines 58-60). Table 1 discloses the colorant, TiO₂, in the amount of 0.1% by weight (column 6).

Regarding claims 16-17, table 2 discloses numerous formulations utilized different flavorants and odorants, it have been obvious to one of ordinary skill in the art at the time the invention was made to have selected specific combinations of flavorings and scents to make different combinations for personal choice to the consumer.

The amount of the fragrance is not disclosed, however, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used whatever amount was necessary or desired in order to obtain the desired level of fragrance in the final product.

The instant claims differ from the references only in the specific percentage selected for the compositions. However, It would have been deemed *prima Facie* obvious to one having ordinary skill in the art at the time of the invention to optimize the percentage of bodying agents, odorants, and flavorants to prepare a composition containing for topical treatment to the lips because the determination of a specific percentage having the optimum therapeutic effect is well within the level of one having ordinary skill in the art, and the artisan would be motivated to determine optimum amounts to get the maximum effect of the active compounds. Therefore, the invention

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as Whole has been prima face obvious to one of ordinary skill in the art at the time the invention was made.

Claims 1-2, 5-6, and 11-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oberthur et al. (US Patent 6,369,042).

Oberthur discloses antioxidative vitamin B analogs in cosmetic formulation (abstract). The formulations can include lip glosses, lip moisturizers, and lip ointments (column 10, lines 10-12). They can comprise emollients including petrolatum and ozokerite (column 30, lines 41-43), alkyl esters of fatty acids having 10-20 carbon atoms, including isopropyl palmitate and isopropyl myristate (column 13, lines 56-63), polyhydric alcohols (column 14, lines 29-44). Flavor oils can also be added in the range of 0-5% of the composition (column 17, lines 24-35). Other ingredients including preservatives, fragrances and colors can be added (column 17, lines 36-42).

Regarding claims 16-17, it have been obvious to one of ordinary skill in the art at the time the invention was made to have selected specific combinations of flavorings and scents to make different combinations for personal choice to the consumer.

The amount of the fragrance is not disclosed, however, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used whatever amount was necessary or desired in order to obtain the desired level of fragrance in the final product.

The instant claims differ from the references only in the specific percentage selected for the compositions. However, It would have been deemed prima Facie

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obvious to one having ordinary skill in the art at the time of the invention to optimize the percentage of bodying agents, odorants, and flavorants to prepare a composition containing for topical treatment to the lips because the determination of a specific percentage having the optimum therapeutic effect is well within the level of one having ordinary skill in the art, and the artisan would be motivated to determine optimum amounts to get the maximum effect of the active compounds. Therefore, the invention as Whole has been prima facie obvious to one of ordinary skill in the art at the time the invention was made.

Claims 1-2, 5-6, and 11-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zofchak et al. (US Patent 6,365,629).

Zofchak discloses fatty acid esters with C1-C50 chain lengths used as emollients (abstract). An emollient effective amount is employed in the composition, which is defined as 0.05% to about 50% by weight (column 6, lines 38-40). The formulations can be in the form of lip glosses and balms (column 7, lines 13-16). Additives including preservatives, fragrances, and pigments may be added in the amount of 0.50-25% by weight (column 7, lines 46-57). Zofchak additionally discloses in the case of lipsticks and lip balms, the esters are present in the amount of 0.5-20% by weight; waxes such as ozokerite, oils such as petrolatum, binders such as isopropyl palmitate and isopropyl myristate, pigments, preservatives, flavoring agents and coloring agents can be added (column 9, lines 20-30).

Regarding claims 16-17, it have been obvious to one of ordinary skill in the art at the time the invention was made to have selected specific combinations of flavorings and scents to make different combinations for personal choice to the consumer.

The instant claims differ from the references only in the specific percentage selected for the compositions. However, It would have been deemed prima Facie obvious to one having ordinary skill in the art at the time of the invention to optimize the percentage of bodying agents, odorants, and flavorants to prepare a composition containing for topical treatment to the lips because the determination of a specific percentage having the optimum therapeutic effect is well within the level of one having ordinary skill in the art, and the artisan would be motivated to determine optimum amounts to get the maximum effect of the active compounds. Therefore, the invention as Whole has been prima face obvious to one of ordinary skill in the art at the time the invention was made.

Conclusion

Due to the new grounds of rejection presented in this office action, this action is made Non-Final. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MELISSA S. MERCIER whose telephone number is (571)272-9039. The examiner can normally be reached on 8:00am-4:30pm Mon through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on (571) 272-8373. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Melissa S Mercier/
Examiner, Art Unit 1615

/MP WOODWARD/
Supervisory Patent Examiner, Art Unit 1615